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09/575,824	05/22/2000	Yukinobu Ishino		2537

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EXAMINER	
CHIEU, PO LIN	

ART UNIT	PAPER NUMBER
2615	12

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/575,824	Applicant(s) ISHINO ET AL.	
	Examiner Polin Chieu	Art Unit 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-65* is/are pending in the application.

4a) Of the above claim(s) *37-64* is/are withdrawn from consideration.

5)☒ Claim(s) *26 and 30* is/are allowed.

6)☒ Claim(s) *1-12,15-24,27,31-36 and 65* is/are rejected.

7)☒ Claim(s) *13,14,25,28 and 29* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2,3,9*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of species I in the reply filed on 4/12/04 is acknowledged. The traversal is on the ground(s) that the search and examination of the entire application could be made without serious burden. This is not found persuasive because Species I discusses the communication of data between a television and storage medium that stores a plurality of still pictures, which requires a search class 386. Species II is directed to the communication of data between a television, printer, and storage medium, which requires a search in class 358. The examiner does not believe that communication between the television and the storage medium and the communication between the television, storage medium, and printer are obvious variations of each other. Therefore, the examiner believes that the search and examination of the different species require serious burden.

The requirement is still deemed proper and is therefore made FINAL.

2. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Information Disclosure Statement

3. The examiner notes that the IDS submitted 6/27/00 (paper no. 6) is a duplicate of the IDS submitted 6/16/00 (paper no. 2).

4. The examiner also notes that references JP 62-21379, JP 8-69684, JP 8-214182, JP 8-102897, JP 9-120666, and JP 9-121313 do not appear to have been provided. These references have not been considered.

Drawings

5. The drawings are objected to because some of the drawing contain minor spelling mistakes (e.g. fig. 28). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be

notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

6. Claim 36 is objected to because of the following informalities: claim 36 recites, "a set of s plurality". Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 3-4, 6, 8-11, 15-16, 18, 20-24, 27, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakamoto et al (6,687,453).

Regarding claim 3, Sakamoto et al discloses a main memory for storing a plurality of digital still image data (col. 7, line 42 – col. 8, line 65); an input circuit for receiving a control signal from the television set (fig. 4, col. 6, line 25 – col. 8, line 65); and an output circuit for transmitting a still image signal on the basis of the digital still image data retrieved by the digital circuit (col. 8, lines 7-65).

Regarding claim 4, Sakamoto et al discloses that the output circuit is designed to transmit the still image signal to the television set (col. 8, lines 7-65).

Regarding claim 6, Sakamoto et al discloses that that the image storage is further connectable to a printer, and wherein the output circuit is designed to transmit the still image signal to the printer (216, fig. 4).

Regarding claim 8, Sakamoto et al discloses that the digital circuit retrieves the desired one of the plurality of digital still image data in response to the control signal received by the input circuit (col. 8, lines 6-65).

Regarding claim 9, Sakamoto et al discloses that the input circuit is designed to received the control signal as a digital signal, and wherein the output circuit includes a digital to analog converter for converting the digital still image to an analog still image signal which is transmitted to the television set (col. 8, lines 20-36).

Regarding claim 10, Sakamoto et al discloses that the integrated digital connector connectable to the television set, the input circuit and the output circuit being connected to the digital connector (105, fig. 4).

Regarding claim 11, Sakamoto et al discloses that a control circuit for controlling the digital circuit and the output circuit in response to the input circuit which receives the control signal (fig. 4, lines 7-65).

Regarding claim 15, Sakamoto et al discloses a temporary memory for storing the digital still image data retrieved from the main memory, the output circuit transmitting the still image signal on the basis of the digital still image data stored in the temporary memory, wherein the digital circuit replaces the digital still image data in the

temporary memory by a new digital still image data retrieved from the main memory in response to the input circuit which receives the control signal (col. 8, lines 7-65).

Regarding claim 16, Sakamoto et al discloses that the output circuit is capable of selectively transmitting a first type of still image signal including information of a single digital still image data and a second type of still image signal including information of a plurality of digital still image data, the output circuit being designed to select one of the first and second types of still image signal in response to the control signal received by the input circuit (col. 8, lines 20-65)

Regarding claim 18, Sakamoto et al discloses that the image storage is capable of being connected to a television set having a remote controller, and wherein the input circuit is designed to receive the control signal which is originated by the remote controller of the set (107, fig. 4).

Regarding claim 20, Sakamoto et al discloses a television circuit including a tuner for receiving a broadcast program (fig. 4); an input circuit for receiving still image transmitted from the image storage (105); a monitor for selectively displaying one of the broadcast program from the television circuit and the still image on the basis of the still image signal received by the input circuit (129); and an output circuit for transmitting a control signal to the image storage (105).

The limitations of claim 21 were discussed in the art rejection of claim 2. Please refer to the art rejection of claim 2.

Regarding claim 22, Sakamoto et al discloses a mode selector (206, fig. 4) for selecting between a first mode for the monitor to display the broadcast program and a

second mode for the monitor to display the still image (col. 6, lines 25-48), and a manually operable member for controlling the television circuit in the first mode and for controlling the output circuit in the second mode (107, col. 8, line 7-65).

Regarding claim 23, Sakamoto et al discloses a main switch, and wherein the television set is turned on in the first mode in response to the main switch (101, fig. 4).

Regarding claim 24, Sakamoto et al discloses a remote controller, wherein the manually operable member is located in the remote controller (107).

The limitations of claim 27 were discussed in the art rejection of claim 1. Please refer to the art rejection of claim 1.

Regarding claim 35, Sakamoto et al discloses a television circuit including a tuner for receiving a broadcast program (fig. 4); a monitor for selectively displaying a single image and a set of a plurality of divided images (col. 8, lines 20-65); a mode selector for selecting between a first mode for the monitor to display the single image and a second mode for the monitor to display the set of images (col. 8, lines 20-65); and a remote controller for controlling the television circuit in the first mode and for selecting one of the plurality of divided images in the second mode (col. 8, lines 45-65).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-2, 34 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Gleim et al (5,146,528).

Sakamoto et al discloses a system including an image storage and television set (fig. 2) wherein the image storage comprises a main memory for storing a plurality of still image data (col. 1, lines 37-47); a digital circuit for retrieving desired one of the plurality of digital still image data from the main memory (not explicitly shown; however, a digital circuit for retrieving still images is inherent to digital cameras); an input circuit for receiving a control signal from the television set (fig. 2); and a first output circuit for transmitting a still image signal to the television set on the basis of the digital still image data retrieved by the digital circuit (fig. 2); and the television set comprises a television circuit including a tuner for retrieving a broadcast program (fig. 4, lines, 126); a monitor for selectively displaying one of the broadcast programs from the television circuit and the still image on the basis of the still image signal transmitted from the image storage by the output circuit (129); and a second output circuit (col. 8, lines 45-65). However, Sakomoto et al does not disclose a second output circuit for transmitting the control signal to the input circuit of the image storage.

Gleim et al teaches a cable that allows the transmission of control signals between devices (whole document). Further, Sakamoto et al discloses retrieving images from the digital camera (col. 8, lines 20-65). Therefore, it would have been obvious to have an output circuit for transmitting the control signal to the input circuit of the image storage (i.e. appears that some type of control signal should be sent to the digital camera to retrieve the still images).

It would have been highly desirable to have an output circuit transmitting the control signal so that the still images can be retrieved from the digital camera.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have an output circuit transmitting the control signal to the image storage device in the device of Sakamoto et al.

Regarding claim 2, Sakamoto et al discloses that the television set further comprising a remote controller, and wherein the second output circuit is designed to transmit the control signal in response to the remote controller (107, col. 8, lines 45-65).

Regarding claim 34, Sakamoto et al discloses a television circuit including a tuner for receiving a broadcast program (fig. 4); an input circuit for receiving an image signal transmitted from the external device (105); and a monitor for selectively displaying one of the broadcast program from the television circuit and the image on the basis of the image signal received by the input circuit (129). However, Sakomoto et al does not disclose an output circuit for transmitting a control signal to the external device in response to the remote controller.

Gleim et al teaches a cable that allows the transmission of control signals between devices (whole document). Therefore, it would have been obvious to have an output circuit for transmitting a control signal to the external device in response to the remote controller.

It would have been highly desirable to have an output circuit transmitting a control signal so that an external device can be controlled simultaneously with another device.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have an output circuit transmitting a control signal to an external device in the device of Sakamoto et al.

Regarding claim 65, Sakamoto et al discloses an image storage connected to a television set (fig. 4); an integrated digital connector connectable to the television set (105); and an input circuit (not shown) and an output circuit being connected to the digital connector (col. 8, lines 20-65). However, Sakamoto et al does not disclose receiving a control signal from the television set (note: while Sakamoto et al does not explicitly disclose sending a control signal from the TV to the digital camera, the examiner believes that a control signal should be sent to the digital camera input circuit).

Gleim et al teaches a connector that allows control signals to be sent between two devices. Therefore, it would have been obvious to have an input circuit receiving a control signal from the television set.

It would have been highly desirable to have an input circuit receiving a control signal from the television set so that a command to reproduce still images could be received, and the operations necessary to provide the images are performed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have an input circuit in the device of Sakamoto et al.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al.

Sakamoto et al does not disclose that the main memory is of a built in type with a large capacity for forming a united database of the digital still image data.

It is well known in the art to have a built in type memory in a digital camera.

It would have been highly desirable to have a built in memory so that an external memory does not have to be used to store images.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a built in type memory in the device of Sakamoto et al.

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Yoshimura et al (5,585,934).

Regarding claim 7, Sakamoto et al does not disclose that the image storage is further connectable to a modulator-demodulator for data communication, and wherein the output circuit is designed to transmit the still image signal to the modulator-demodulator.

Yoshimura et al teaches that the image storage is connectable to a modulator-demodulator for data communication and wherein the output circuit is designed to transmit the still image signal to the modulator-demodulator (col. 1, line 20 – col. 2, line 31).

It would have been highly desirable to have connectable modulator-demodulator so that the still image data can be reproduced on a TV monitor or the like.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a connectable modulator-demodulator in the device of Sakamoto et al.

13. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Rilly (6,085,017).

Regarding claim 12, Sakamoto et al does not disclose that the main memory has a rested condition and an active condition both with a main power supplied, wherein the main memory is changed between the rested condition and the active condition in response to the input circuit which receives the control signal.

Rilly teaches a device that has a rested condition that is changed to an active condition in response to a received control signal (col. 1, lines 29-60).

It would have been highly desirable to have a rested condition so that the power consumption of the device is low.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a rested condition in the device of Sakamoto et al.

14. Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Escallon (5,799,157).

Regarding claim 17, Sakamoto et al does not disclose that the output circuit is designed to replace the second type of still image signal by the first type of still image signal in response to the control signal received by the input circuit with the second type of image signal transmitted for a selection among the plurality of digital still image data included therein.

Escallon teaches that the output circuit is designed to replace the second type of still image signal by the first type of still image signal in response to the control signal received by the input circuit with the second type of image signal transmitted for a

selection among the plurality of digital still image data included therein (col. 3, line 61 – col. 4, line 9).

It would have been highly desirable to have the mode changed during a slide show when a user selects an image of interest so that a user can view an image of interest without having to input a mode switching command.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to change from a second type of still image to a first type in response to a control signal in the device of Sakamoto et al.

15. Claims 19, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Jung (5,109,284).

Regarding claim 19, Sakamoto et al discloses a main switch (101). However, Sakamoto et al does not discloses turning the image storage on or off in response to the control signal.

Jung teaches turning on or off an external device in response to the control signal (col. 2, lines 30-67). It would have been obvious to turn the image storage on or off in response to a control signal.

It would have been highly desirable to have the image storage turned on or off in response to a control signal so that the connected devices are turned on and off together with a single command (col.2, line 64 – col. 3, line 5).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to turn on and off the image storage in the device of Sakamoto et al.

Regarding claims 31-33, Sakamoto et al discloses a television circuit including a tuner for receiving a broadcast program (fig.4); input circuit for receiving an image transmitted from the external device (105); a monitor for selectively displaying one of a broadcast program from the television circuit and the image on the basis of the image signal received by the input circuit (129); and a main switch (101). However, Sakamoto et al does not disclose an output circuit for transmitting a control signal to turn on the external device when the main switch is turned on and transmitting a control signal to turn off the external device when the main switch is turned off.

Jung teaches a VCR that turns on a TV when the VCR is turned on; and turning the TV off when the VCR is turned off (col. 2, lines 30-67). Therefore, it would have been obvious to have an output circuit for transmitting a control signal to turn on the external device when the main switch is turned on and transmitting a control signal to turn off the external device when the main switch is turned off.

It would have been highly desirable to have an output circuit to turn off and on the external device so that the TV and the external device can be simultaneously controlled without having to use an additional line (col.2, line 64 – col. 3, line 5).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have an output circuit to turn on and off the external device in the device of Sakamoto et al.

16. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Torres et al (6,738,075).

Regarding claim 36, Sakamoto et al discloses that the remote controller includes a set of a plurality of manually operable members to be commonly used in the first and second modes (col. 8, lines 20-65). However, Sakamoto et al does not disclose that the set of a plurality of images are arranged in a similar pattern to that of the manually operable members.

Torres et al teaches a pattern of image display including a set of nine images (fig. 4A). Further, it is commonly known that remote controller often have numerical buttons 1-9 arrange it a similar pattern (specifically in the order from 1 to 9) as the image set.

It would have been highly desirable to have image pattern shown in Torres et al so that easy selection of an image is facilitated with the remote controller.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have the image pattern in the device of Sakamoto et al.

Allowable Subject Matter

17. Claims 26 and 30 are allowed.

18. The following is an examiner's statement of reasons for allowance: the prior art disclose a television circuit, an input circuit, a monitor and a mode selector, as discussed in the previous art rejections. Regarding claim 26,the prior art fails to disclose that the mode selector is designed to automatically change from a second mode (displaying images from the external device) to the first mode (displaying the broadcast program) when the external device is turned off with the television set in the second mode. Regarding claim 30, the prior art fails to disclose an output circuit for

transmitting a control signal to make the external device inoperative when the mode selector selects the first mode with the television set in the second mode. Note that inoperative is defined as not working. Therefore, the examiner has interpreted inoperative to be the equivalent of turning off.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

19. Claims13-14, 25, and 28-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Parulski, Aotake et al, and Fellegara et al disclose slide shows; Xu discloses an internal memory; Duffield discloses an automatic switching device; and Suzuki, Narushima, Maeda et al, and Williams et al disclose digital cameras.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Polin Chieu whose telephone number is (703) 308-6070. The examiner can normally be reached on M-Th 8:00 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B. Christensen can be reached on (703) 308-9644. The fax phone

numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PC
June 28, 2004